

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**  
**Attorney Docket No. 14964US01**

In the Application of: )  
Gupta, et al. ) **Electronically Filed**  
Serial No.: 10/765,800 )  
Filed: January 27, 2004 ) **Dated: April 29, 2008**  
For: Usage Of Digital Input/Output )  
Card As MPEG Transport Streamer )  
Examiner: Lee, John W. )  
Group Art Unit: 2624 )  
Conf. No.: 2483 )

## **PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Mail Stop Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

Sir:

Assignee hereby requests pre-appeal review of certain rejections set forth in the final office action of 2/1/08.

## REMARKS

Claims 1-10 are presently pending and stand rejected.

Claims 1 and 6 were rejected under 35 U.S.C. § 103(a) as being anticipated by Tskagoshi in view of Botsford. Claim 1 recites, among other limitations, “a processor for encoding the reference video” and “second memory for storing a decoded reference video”. Assignee respectfully traverses the rejection because the combination of Tskagoshi in view of Botsford does not teach “second memory for storing a decoded reference video”, and furthermore, even if the combination of does teach the foregoing, the Botsford teaches away from combination with Tskagoshi’s alleged teaching of “a processor for encoding the reference video”.

Examiner has indicated that Tskagoshi teaches, “a processor (Fig. 1b-130, ‘system control’; paragraph [0028]) for encoding the reference video”. Office Action at 2-3. Examiner has indicated that Botsford discloses “a second memory (Fig. 1-16, 17, 18 and 19, ‘buffer’) for storing a decoded reference video (col. 5, lines 10-16; col. 10, lines 28-31).” Office Action at 3. Botsford, Fig. 1, reference 16, 17, 18, and 19 are shown below:

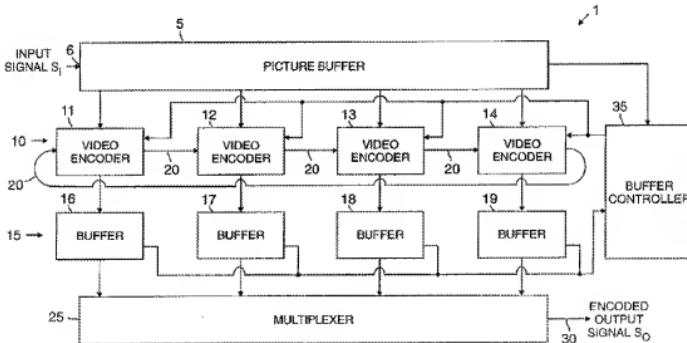


FIG. 1

It can clearly be seen that the Buffers 16, 17, 18, and 19 receive input from video encoders 11, 12, 13, and 14. Thus, the buffers are not “storing a decoded reference video” as claimed. Accordingly, Assignee respectfully traverses Examiner’s assertion that

Botsford discloses “a second memory (Fig. 1-16, 17, 18 and 19, ‘buffer’) for storing a decoded reference video (col. 5, lines 10-16; col. 10, lines 28-31).”

It is noted that Examiner makes reference to Botsford, col. 10, lines 28-31. Botsford, col. 10, line 28-31 state:

A decoding circuit in accordance with the present invention may be constructed and operate in an identical manner as the encoder circuit 1 of Fig. 1, except that predictive decoders would replace the encoders 10.

To the extent that Examiner relies on the foregoing statement to establish that Botsford, Figure 1-16, 17, 18, and 19 teach “a second memory for storing a decoded reference video”, Assignee respectfully traverses the rejection because Botsford teaches away from Examiner’s proposed combination.

Examiner has stated that “it would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made to use Botsford’s invention in Tsukagoshi’s invention to provide a system that reduces the hardware and interconnection complexity as suggested by Botsford (col. 1, lines 61-63). However, Assignee respectfully submits Botsford also teaches “except that predictive decoders would replace the encoders 10”. Given the foregoing teaching, it would not be obvious to one skilled in the art to combine Tsukagoshi’s teaching of “a processor (Fig. 1b-130, ‘system control’; paragraph [0028]) for encoding the reference video (Fig. 1b-115; paragraph [0029], ‘video encoder’)” with Botsford’s teaching that “A decoding circuit in accordance with the present invention may be constructed and operate in an identical manner as the encoder circuit 1 of Fig. 1,” because of Botsford’s further teaching that “that predictive decoders would replace the encoders 10”, that specifically teaches away from this.

“If the examiner determines there is factual support for rejecting the claimed invention under 35 U.S.C. 103, the examiner must then consider any evidence supporting the patentability of the claimed invention, such as any evidence in the specification or any other evidence submitted by the applicant.” MPEP 2142. “When an applicant submits evidence, whether in the specification as originally filed or in reply to a rejection, the examiner must reconsider the patentability of the claimed invention. The decision on patentability must be made based upon consideration of all the evidence, including the

evidence submitted by the examiner and the evidence submitted by the applicant. A decision to make or maintain a rejection in the face of all the evidence must show that it was based on the totality of the evidence. Facts established by rebuttal evidence must be evaluated along with the facts on which the conclusion of obviousness was reached, not against the conclusion itself. *In re Eli Lilly & Co.*, 902 F.2d 943, 14 USPQ2d 1741 (Fed. Cir. 1990).” Id.

Assignee respectfully submits that, notwithstanding Botsford, Col. 1, Lines 61-63, when consideration is given to all the evidence, it clearly would not be obvious to one skilled in the art to combine Tskagoshi and Botsford as suggested by Examiner.

Accordingly, for the foregoing reasons, the combination of Tskagoshi in view of Botsford does not teach the claimed “a second memory for storing a decoded reference video”. Moreover, even if Botsford is held to teach the foregoing, Botsford teaches away from combination with Tskagoshi’s alleged teaching of “a processor for encoding the reference video”.

Accordingly, Assignee respectfully requests that the rejections to claims 1 and 6 be withdrawn.

## CONCLUSION

For at least the foregoing reasons, each of the pending claims are now in a condition for allowance and Examiner is requested to pass this case to issuance.

The Commissioner is hereby authorized to charge additional fees or credit overpayments to the deposit account of McAndrews, Held & Malloy, Account No. 13-0017.

Dated: April 29, 2008

Respectfully submitted,



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